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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,185	11/07/2000	J.P. Leon	06969-025610US	1155
20350	7590	01/19/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,185

Applicant(s)

LEON ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-57 is/are pending in the application.
- 4a) Of the above claim(s) 55-57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-40 is/are allowed.
- 6) ☒ Claim(s) 41-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/13/01, 6/8/01
9/12/02, 10/31/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 24-54, drawn to a method, system or apparatus for determining correct insertion orientation, classified in class 101, subclass 485.
 - II. Claims 55-57, drawn to a reversible sheet, classified in class 428, subclass 40.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as printable media for use in any type of printer or method that doesn't include steps, code or software for prompting by a computer. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with David Slone on 12/15/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 24-54. Affirmation of this election must be made by applicant in replying to this Office action. Claims 55-57 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 41 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP 6-199016) in view of Nakajima (JP 5-64926).

With respect to claim 41, Sato discloses the claimed method except for the steps of prompting with a computer. Sato discloses a user inserting a printable medium (a note as disclosed by Sato) into a printer in a first orientation (an inherent step if a printer is to be supplied with a medium so that it can print on a medium as discussed in the Constitution portion of the English abstract of Sato). Sato further discloses printing a test mark Y to an actual location on the printable medium with the printer. Additionally, Sato discloses that if the test mark Y is not printed correctly the position of the note in the printer is adjusted to repeat the printing of the test pattern. It would have been obvious to one of ordinary skill in the art to reinsert the media, if needed, through routine experimentation of printing positions. Furthermore, the steps of prompting with the computer is simply an automated display of what the operator of the printer is doing. It has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior

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art (see MPEP § 2144.04, part III). In this case, the computer is merely automatically displaying what the operator is thinking. Nakajima teaches that is known to prompt, with a computer, a user change the feed direction of a print media. Additionally, it would have been obvious to repeat the steps as many times as necessary in order to correctly print the printable medium by routine experimentation.

With respect to claims 51 and 52, Sato in view of Nakajima discloses the claimed method and an apparatus of carrying out the method as mentioned above with respect to claim 41. The operation of a printer and a computer as disclosed by Sato inherently requires the use of software or code. The term module can be interpreted as being a segment of code. Thus such modules are inherent in the apparatus. Sato discloses in paragraph [0006] that a printer and computer are used for carrying out the method.

7. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP 6-199016) in view of Nakajima (JP 5-64926), as applied to claim 41 above, and further in view of Ogg et al. (US 6965451).

With respect to claim 42, Sato in view of Nakajima discloses the claimed method except for the printable medium being a label sheet. However, Ogg et al. teaches that it is known to print on label sheets (Ogg et al., col. 7, lines 11-13). It would have been obvious to combine the teaching of Ogg et al. with the method disclosed by Sato in view of Nakajima for the advantage of adhesively attaching a printed item to another surface.

With respect to claim 43, Ogg et al. also teaches printing on envelopes (col. 7, lines 11-13).

With respect to claim 44, Sato in view of Nakajima disclose the steps as mentioned above with respect to claim 41 and Ogg et al. teaches a label sheet as mentioned above with respect to claim 42. It would have been obvious to combine the teaching of Ogg et al. with the method disclosed by Sato in view of Nakajima for the advantage of adhesively attaching a printed item to another surface.

8. Claims 45, 48-49 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP 6-199016) in view of Nakajima (JP 5-64926), as applied to claim 41 above, and further in view of Sasai et al. (JP 10-211747).

With respect to claims 45 and 49, Sato in view of Nakajima disclose the claimed method as mentioned above with respect to claim 41, except for the step of providing a plurality of orientation markings. Figure 1 of Sato shows just one orientation marking X on the provided printable medium. However, Sasai et al. teaches providing a printable medium with a plurality of orientation markings 5 and 6 as shown in Figure 1 of Sasai et al. It would have been obvious to combine the teaching of Sasai et al. with the method disclosed by Sato in view of Nakajima for the advantage of providing the operator with a better sense of orientation of how the printable medium is to be oriented by supplying orientation markings on each side of the paper.

With respect to claim 48, Figure 7 of Sasai et al. shows an embodiment with four orientation markings 5, 7, 9 and 10.

With respect to claims 53 and 54, Sato in view of Nakajima and Sasai et al. discloses the claimed method and an apparatus of carrying out the method as mentioned above with respect to claim 45. The operation of a printer and a computer as disclosed by Sato inherently requires the

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use of software or code. The term module can be interpreted as being a segment of code. Thus such modules are inherent in the apparatus. Sato discloses in paragraph [0006] that a printer and computer are used for carrying out the method.

9. Claims 46-47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP 6-199016) in view of Nakajima (JP 5-64926) and Sasai et al. (JP 10-211747), as applied to claim 45 above, and further in view of Ogg et al. (US 6965451).

With respect to claim 46, Sato in view of Nakajima and Sasai et al. discloses the claimed method except for the printable medium being a label sheet. However, Ogg et al. teaches that it is known to print on label sheets (Ogg et al., col. 7, lines 11-13). It would have been obvious to combine the teaching of Ogg et al. with the method disclosed by Sato in view of Nakajima and Sasai et al. for the advantage of adhesively attaching a printed item to another surface.

With respect to claim 47, Ogg et al. also teaches printing on envelopes (col. 7, lines 11-13).

With respect to claim 50, Sato in view of Nakajima and Sasai et al. disclose the claimed method as mentioned above with respect to claim 45. Ogg et al. teaches that it is known to print on label sheets (Ogg et al., col. 7, lines 11-13). It would have been obvious to combine the teaching of Ogg et al. with the method disclosed by Sato in view of Nakajima and Sasai et al. for the advantage of adhesively attaching a printed item to another surface.

Allowable Subject Matter

10. Claims 24-40 are allowed.

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11. The following is a statement of reasons for the indication of allowable subject matter:

Claims 24-29 and 36-40 have been allowed primarily for the step of prompting, with a computer, a user to place a first mark on a sheet of paper, printing a second mark to the sheet of paper with a printer and prompting, with the computer, the correct insertion orientation for a label sheet based upon the location of the first and second marks.

Claims 30-32 have been allowed primarily for the module for prompting, with a computer, a user to place a first mark on a sheet of paper, a module for printing a second mark to the sheet of paper with a printer and a module for prompting, with the computer, the correct insertion orientation for a printable medium based upon the location of the first and second marks.

Claims 33-35 have been allowed primarily for the code for prompting a user to place a first mark on a sheet of paper, code for printing a second mark to the sheet of paper with a printer and code for prompting the user with the correct insertion orientation for a printable medium based upon the location of the first and second marks.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Herzen et al. and Tinney are cited to show other examples of a printer prompting a user to determine if the print media has been inserted correctly.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. J. Colilla', with a long horizontal stroke extending to the left.

Daniel J. Colilla
Primary Examiner
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January 5, 2006